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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/710,999 | 11/09/2000 | Tetsunosuke Fujisaki | YO999-527 | 5835 |

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07/14/2004

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3624

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/710,999

Applicant(s)

FUJISAKI, TETSUNOSUKE

Examiner

Narayanswamy Subramanian

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 6-16, 22-31 and 33-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 17-21 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Applicant's response to restriction requirement filed on May 10, 2004. Claims 1-35 are currently pending. The Examiner acknowledges applicant's election with traverse of Group I claims 1-5, 17-21 and 32. Claims 6-16, 22-31 and 33-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant is respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 1-5, 17-21 and 32 have been examined. The response to restriction/election requirement and rejections are stated below.

Response to Restriction/Election Requirement

2. Applicant's arguments in regards to the restriction requirements have been considered but are non persuasive for the reasons given below. As discussed in the last office action (Paper No. 6) the groupings of invention are distinct and separate for the reasons given therein even though they are not classified into a separate class or subclass. These inventions require separate searches. The Applicants' submission that a search and examination of groups I and II claims together would not impose a serious burden on the Examiner is not a test of "serious additional burden" imposed on the examiner. Hence the restriction of the claims is maintained.

Claim Rejections - 35 USC § 101

3. The claims 1-5 of the invention are rejected under 35 USC § 101 because they are directed to non-statutory subject matter. Claim 1 is drawn to a method for processing transactions involving financial securities that is not tied to any technological art. Similarly the dependent claims 2-5 are not tied to any technological art. Claims 1-5 are

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directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 cites in the preamble "system for processing transactions involving financial securities". It is not clear if the claimed invention is a method or an apparatus. Claims 18-21 are rejected because they depend on the rejected claim 17. Clarification is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole

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would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5, 17-21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US Patent 6,266,651 B1) in view of et al (US Patent) and further in view of et al (US Patent).

With reference to claims 1, 17 and 32, Woolston teaches a method, a system and an article of manufacture respectively for processing transactions, the method comprising the steps of: establishing a plurality of market segments, each of said market segments having at least one market participant (See Woolston Column 1 lines 51-57, the tiers constitute the market segments); receiving a bid for one or more goods, said bid including one or more authorized market segments (See Woolston claim 35, receiving bids from retail segment is implied in the disclosure); and posting said bid only to said one or more authorized market segments (See Woolston claims 5 and 18, privileges available to only one segment is interpreted to include this feature). A system for processing transactions, comprising a memory that stores computer-readable code and a processor operatively coupled to said memory and an article of manufacture comprising a computer readable medium having computer readable code means embodied thereon are inherent in the disclosure of Woolston.

Woolston does not teach the feature wherein the goods are financial securities.

Silverman teaches the feature wherein the goods are financial securities (See Silverman Column 3 lines 50-55).

Both Woolston and Silverman are concerned with the problem of processing transactions involving two parties. It would have been obvious to one with ordinary skill

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in the art at the time the invention was made to include the feature taught by Silverman to the disclosure of Woolston. The combination of the teaching taken as a whole suggests that parties to the transaction would have benefited from being able to communicate and negotiate other terms with each other before finalizing the transaction.

With reference to claims 2, 3, 18 and 19, Woolston teaches the steps of preventing said bid from being posted to market participants not in said one or more authorized market segments (See Woolston Claims 5 and 18, privileges available to only one segment is interpreted to include the step of preventing said bid from being posted to market participants not in said one or more authorized market segments) and the step of comparing said bid to other pending bids to identify pending bids that are in proximity to said received bid (See Woolston claim 35, selectively displacing a bid implies comparing said bid to other pending bids to identify pending bids that are in proximity to said received bid).

With reference to claims 4 and 20, Silverman teaches the step of establishing a communication channel between entities associated with two bids that are in proximity (See Silverman Column 3 lines 40-44 and 60-64).

With reference to claims 5 and 21, Silverman teaches the step wherein two bids are in proximity if they have parameters that are within a given threshold of each other (See Silverman Column 4 lines 35-47).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone

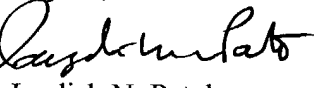
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number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to the Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian

July 12, 2004



Jagdish N. Patel
Primary Examiner